

Kelly C. Hunsaker (SBN 168307 / hunsaker@fr.com)
Enrique D. Duarte (SBN 247523 / duarte@fr.com)
FISH & RICHARDSON P.C.
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

Attorneys for Defendant
COUPA SOFTWARE INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(SAN FRANCISCO DIVISION)

ARIBA, INC.,

Plaintiff,

V.

COUPA SOFTWARE INC.

Defendant.

Case No. 4:12-cv-01484 WHO

COUPA'S RESPONSIVE CLAIM CONSTRUCTION BRIEF

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	TECHNOLOGY OF THE ‘165 PATENT	1
A.	Brief Background	1
B.	The ’165 Specification	2
C.	The ’165 Prosecution History	4
D.	The Asserted Claims	5
III.	THE LAW OF CLAIM CONSTRUCTION	5
A.	The “Direct Order Module,” “Purchase Order Module,” and “Electronic Requisition Form”	7
1.	“direct order module” (All Claims).....	8
2.	“purchase order module” (All Claims)	10
3.	“electronic requisition form” (claims 35, 41)	12
B.	The Means-Plus-Function Limitations (35 U.S.C. § 112(f))	14
1.	“order generating means for deciding between at least one of a purchase card module, a direct order module, and a purchase order module to submit the requisition for fulfillment by a supplier” (Claim 1).....	16
2.	“deciding between at least one of a purchase card module, a direct order module, and a purchase order module to submit the electronic requisition form for fulfillment” (Claims 35, 41).....	19
3.	“approval path handling means for guiding the requisition record along the determined approval path, wherein the approval path handling means generates a global approval indication based on the commentary entry and in response to the requisition record successfully traversing the approval path” (Claim 1).....	20
4.	“approval path determining means, responsive to the requisition record to approval rules in an approval rules database, for determining an approval path for the requisition record, among various ones of a plurality of possible approvers, required to approve the requisition record based on the commentary entry” (Claim 1)	22

1 **TABLE OF CONTENTS (Cont'd.)**

2
3 5. “requisition record generating means . . .” (Claim 1) 24
4 6. “electronic receipt generating means . . .” (Claim 1) 25
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF AUTHORITIES

Cases

4	<i>Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech.</i> , 521 F.3d 1328 (Fed. Cir. 2008).....	15, 16
5	<i>Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.</i> , 672 F.3d 1335 (Fed. Cir. 2012).....	14
6		
7	<i>Biomedino, LLC v. Waters Techs. Corp.</i> , 490 F.3d 946 (Fed. Cir. 2007).....	14, 15
8		
9	<i>Black & Decker, Inc. v. Robert Bosch Tool Corp.</i> , 260 Fed. Appx. 284 (Fed. Cir. 2008).....	13
10		
11	<i>Blackboard Inc. v. Desire2Learn Inc.</i> , 574 F.3d 1371 (Fed. Cir. 2009).....	15, 21, 23, 24
12		
13	<i>Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.</i> , 412 F.3d 1291 (Fed. Cir. 2005).....	14
14		
15	<i>Embrex, Inc. v. Serv. Eng'g Corp.</i> , 216 F.3d 1343 (Fed. Cir. 2000).....	5
16		
17	<i>ePlus, Inc. v. Lawson Software, Inc.</i> , 700 F.3d 509 (Fed. Cir. 2012).....	passim
18		
19	<i>Ergo Licensing, LLC v. CareFusion 303, Inc.</i> , 673 F.3d 1361 (Fed. Cir. 2012).....	14, 15, 25
20		
21	<i>Finisar Corp. v. DirecTV Group, Inc.</i> , 523 F.3d 1323 (Fed. Cir. 2008).....	9, 21
22		
23	<i>Function Media, L.L.C. v. Google, Inc.</i> , 708 F.3d 1310 (Fed. Cir. 2013).....	19
24		
25	<i>Griffin v. Bertina</i> , 285 F.3d 1029 (Fed. Cir. 2002).....	21, 25
26		
27	<i>Intamin Ltd. v. Magnetar Tech., Corp.</i> , 483 F.3d 1328 (Fed. Cir. 2007).....	10
28		
29	<i>Intergraph Hardware Techs. Co. v. Toshiba Corp.</i> , 508 F. Supp. 2d 752 (N.D. Cal. 2007)	20, 25
30		
31	<i>IPXL Holdings, LLC v. Amazon.com</i> , 430 F.3d 1377 (Fed. Cir. 2005).....	22
32		
33	<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996).....	5
34		

1	<i>Mas-Hamilton Group v. LaGard, Inc.</i> , 156 F.3d 1206 (Fed. Cir. 1998).....	19
2	<i>Net MoneyIN, Inc. v. VeriSign, Inc.</i> , 545 F.3d 1359 (Fed. Cir. 2008).....	23
4	<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005).....	6, 16, 19
5	<i>TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.</i> , 529 F.3d 1364 (Fed. Cir. 2008).....	10
7	<i>Vitronics Corp. v. Conceptronic, Inc.</i> , 90 F.3d 1576 (Fed. Cir. 1996).....	6
8	<i>WMS Gaming, Inc. v. Int'l Game Tech.</i> , 184 F.3d 1339 (Fed. Cir. 1999).....	15
10	<u>Statutes</u>	
11	35 U.S.C. §112(f)	passim

12		
13		
14		
15		
16		
17		
18		
19		
20		
21		
22		
23		
24		
25		
26		
27		
28		

1 **I. INTRODUCTION**

2 This is a patent case involving an upstart software company defending itself against a
 3 competitor's attempt to impede its rising success. At issue is U.S. Patent No. 7,117,165 (the "'165
 4 patent"), a patent filed during the hey-day of the 1990s dot-com era that discloses a specific
 5 electronic procurement system—i.e., a system that employees can use to request things like
 6 staplers, paper, and pencils. At the time the patent was filed, procurement had generally been
 7 done "through paper-based processes," and the patent sought to put together the various processes
 8 into an "integrated, enterprise-wide solution." [1:20-34¹.] The patent issued in 2006 after seven
 9 years of prosecution in the Patent Office, after Ariba had narrowed the claims multiple times.

10 There are two central themes to the present claim construction dispute. First, Coupa
 11 proposes constructions that account for the distinction the '165 patent made between a requisition
 12 and a purchase order. Ariba, on the other hand, proposes constructions that blur that distinction.
 13 Second, the patent contains claims drafted in "means-plus-function" format. Means-plus-function
 14 claims trigger special rules allowing a patentee to claim its invention in terms of the *function* it
 15 performs, but as a *quid-pro-quo*, are limited to the particular *structures* disclosed in the patent
 16 specification for performing that function. If there is insufficient disclosure, the claim is invalid,
 17 since a patentee cannot claim to itself *all* ways of performing a function.

18 **II. TECHNOLOGY OF THE '165 PATENT**

19 **A. Brief Background**

20 Broadly speaking, procurement is the process an organization uses to purchase items. It
 21 generally involves an employee filling out a requisition form to request approval to purchase
 22 items, obtaining those approvals, and then ordering the approved items.

23 A company can place an order in at least three ways. For example, the company can send
 24 a purchase order to a supplier. A purchase order is a contractual offer to purchase items, and thus
 25 must set out the terms and conditions of that offer and a purchase order number (an ID for the
 26 purchase order). If the supplier accepts, it typically ships the requested items along with an
 27

28 ¹ Unless otherwise noted, citations in the form XX:YY refer to the '165 Patent, col. XX, ln. YY.

1 invoice for payment. The invoice will refer to the purchase order number so the buying company
 2 can match the invoice to the corresponding purchase order. This is crucial for large companies so
 3 they can avoid paying invoices for orders they did not actually make.

4 Where there are periodic or repetitive purchases of the same set of materials, e.g., staples,
 5 pencils, paper, etc., a company may enter into a standing agreement with a supplier. The company
 6 and supplier agree beforehand what items are covered and the terms and conditions that will apply,
 7 eliminating the need for purchase orders. With such an agreement, the supplier can send periodic
 8 invoices covering all orders placed under the agreement within a set period of time, e.g., within a
 9 quarter, but without the overhead of matching those invoices to purchase orders.

10 Yet another way to place orders involves using purchase cards, which function in some
 11 respects like a credit card. Purchase cards were introduced at least as early as 1986 as part of a
 12 Federal Government pilot test to save costs for small purchases (Dkt. No. D12-2 at 2) and are well
 13 suited for one-off small transactions that may not be covered by a standing agreement. With
 14 purchase cards, a company pays for the order at the time of purchase, similar to how an individual
 15 may use a credit card to pay for items at a check-out stand, over the phone, or over the Internet
 16 (e.g., at Amazon.com). This renders invoices, and the associated cost of having to match invoices
 17 to purchase orders, unnecessary.

18 **B. The '165 Specification**

19 Procurement in the '165 patent starts with a requisition, which requests approval to
 20 purchase goods or services and may contain multiple line items from different suppliers. [7:37-38;
 21 19:30-32; 23:52-57.] Figure 3 shows "how a requisition is processed in a typical embodiment,
 22 from requisition creation to approval, to receipt of requisitioned goods/services, and to
 23 reconciliation." [3:18-21.] The system first creates a requisition using the steps indicated in box
 24 302 of Figure 3. [3:21-23.] For example, a "wizard 202, 302 'walks' an employee through a
 25 number of questions to guide him through the process of making a purchase." [3:30-32.]

26 The system then handles the requisition approval process. "When an employee has
 27 finished filling out a requisition and asked to submit it, the system will perform [a number of]
 28 checks before actually submitting the requisition for approval." [10:23-26.] For example, "the

1 system checks the approval rules of the company, decides which users need to approve the
 2 request, and in what order, and then notifies the first approver that there is a requisition waiting for
 3 attention.” [10:61-64.] The ’165 patent mentions that “approval rules are defined as part of the
 4 installation process” (16:39-42), but does not actually disclose a set of approval rules. [Ex. ² 2,
 5 Deposition of Michael I. Shamos (“Shamos Tr.”), at 134:21-135:3 (the patent “doesn’t disclose
 6 the rules themselves”).]

7 After approval of a requisition, the system chooses which ordering module to use. “An
 8 ordering module is the piece of the system that takes a fully approved requisition and submits it
 9 for fulfillment.” [19:26-27.] “When a requisition has been fully approved, the system will: . . .
 10 [c]heck the requisition to determine which suppliers are involved, and . . . [c]hoose the preferred
 11 ordering module for each of those suppliers and use it to transmit the order.” [19:28-34.] “The
 12 three ordering modules are a Purchasing Card Module, Direct Order Module, and a Purchase
 13 Order module.” [19:35-36.]

14 “The Purchasing Card ordering module supports the use of purchasing cards as a payment
 15 mechanism.” [19:38-39.] “Purchasing card transactions are reconciled on some regular basis with
 16 the bank that issued the purchasing card.” [19:43-45.] A purchase card transaction is assigned a
 17 “P-Card Order #” that is “used to identify the transaction in communications between the supplier
 18 and the system.” [20:29-32.]

19 “The direct order module is an ordering module that supports communication of orders
 20 directly between the buyer and supplier, without storing the requisition in an ERP system.”
 21 [20:64-67.]³ Using this module, the system of the ’165 patent sends the requisition directly to the
 22 supplier because they have a “direct order agreement,” that is, an agreement that “includes terms
 23 and conditions, and specifies the frequency of billing.” [21:1-3.] Separate purchase orders are not
 24 generated with the direct order module. Instead, if the direct order module is used, the system

25
 26 ² Unless otherwise noted, all exhibits herein refer to exhibits attached to the Declaration of
 27 Enrique D. Duarte (“Duarte Decl.”).
 28 ³ ERP stands for Enterprise Resource Planning; an ERP system is a software system that
 handles business operations including procurement. See, e.g., ALEXIS LEON, ENTERPRISE
 RESOURCE PLANNING 14 (2nd ed. 2008).

1 “[t]ransmits *the requisition* directly to the supplier via fax or e-mail.” [21:15-16 (emphasis
 2 added).]

3 Finally, “[t]he purchase order module is an ordering module whose case results in a
 4 purchase requisition in the ERP system.” [21:26-27.] “Once the requisition is in ERP,” an agent
 5 “can manipulate it with standard ERP operations,” for example, he can “autocreate[] a purchase
 6 order from the requisition, print[] it out, an[sic] send[] it to the supplier for fulfillment.” [21:29-
 7 34.] The ’165 patent discloses a “requisition adapter” (an ERP adapter) that “pushes fully-
 8 approved requisitions into the ERP, where they are converted into Purchase Orders on the ERP
 9 system.” [23:52-55.] Each line item of an approved requisition receives its own “purchase order
 10 number” in the ERP system. [*See* 23:55-57.]

11 According to the ’165 patent, “the only time the system generates a purchase order,” as
 12 opposed to an ERP system generating a purchase order, is when the system is “stand-alone,” i.e.,
 13 “when there is no ERP adapter present.” [26:30-38.] In that case, features of the system are
 14 available “*only* to provide basic functionality....” and the system “[p]rovides the ability to print
 15 out purchase orders and transmit them to the supplier.” [*Id.*] Such “printed purchase orders
 16 include standard notes (such as the supplier’s terms and conditions) and a purchase order number.”
 17 [26:34-37.]

18 After an order is placed and the items are received, the requester acknowledges receiving
 19 them and the system generates a receipt. [*See* 4:60-65.]

20 **C. The ’165 Prosecution History**

21 The ’165 patent was filed October 28, 1999, claims priority to a provisional application
 22 filed on April 28, 1997, and ultimately issued on October 3, 2006.

23 The U.S. Patent & Trademark Office (“USPTO”) rejected the initial set of claims in 2002
 24 as obvious based on three prior art patents: U.S. Patent No. 5,319,542 (“King patent”), U.S. Patent
 25 No. 5,758,327 (“Gardner patent”), and U.S. Patent No. 5,315,504 (“Lemble patent”). [Dkt. No.
 26 44-3 at ARICOU00000205-12 (Jul. 5, 2002 Office Action, at 6-13).] In response, Ariba added
 27 new claims and amended the original ones to require that a requisition record include a
 28 “commentary entry” and that approvals be “based on the commentary entry.” [*Id.* at

1 ARICOU00000235-36 (Oct. 15, 2002 Am. at 14-15).] The USPTO maintained its rejection, and
 2 after some back and forth, Ariba again amended its claims, this time adding limitations such as an
 3 “electronic receipt” and “transmitting the electronic requisition form.” [Ex. 1 (Apr. 10, 2003 Am.
 4 at 2).] Again, the USPTO maintained its rejection over the same prior art. More back and forth
 5 ensued, and Ariba eventually cancelled some claims and amended others (again). Ariba added
 6 more claim limitations to try to overcome the prior art; for example it added a “wherein” clause
 7 requiring the receipt to indicate acceptance or rejection of a received resource, specified that the
 8 requisition form is transmitted “directly” to at least one of the suppliers, and added a “facilitating
 9 payment” limitation. [Ex. 1 (Mar. 31, 2004 Am. at 2, 10-13).] The USPTO remained
 10 unconvinced and again rejected Ariba’s claims.

11 Finally, Ariba amended every independent claim to explicitly require “deciding between”
 12 three different ordering modules – the Purchase Card module, Direct Order module and Purchase
 13 Order module – arguing that the King, Gardner, and Lemble patents did not suggest “choosing
 14 between multiple order modules to fulfill an order.” [Ex. 1 (Jan. 13, 2005 Am. at 3, 10, 12, 14-15,
 15 20).] With this addition, the USPTO finally allowed the claims.

16 **D. The Asserted Claims**

17 The ’165 patent has three independent claims. Independent claim 1 is a system claim that
 18 generates an electronic requisition record, determines an approval path for that record, guides the
 19 record along that path, decides which ordering module to use, and ultimately generates a receipt.
 20 This claim is written in means-plus-function format, which has special statutory requirements
 21 under 35 U.S.C. §112(f). Independent claims 35 and 41 are “computer-readable medium” claims
 22 that are similar to claim 1, except they omit the approval path limitations, and recite the additional
 23 limitation of transmitting a requisition form directly to one or more suppliers.

24 **III. THE LAW OF CLAIM CONSTRUCTION**

25 Courts construe claims as a matter of law. *Markman v. Westview Instruments, Inc.*, 517
 26 U.S. 370, 391 (1996). “The construction of claims is simply a way of elaborating the normally
 27 terse claim language in order to understand and explain, but not to change, the scope of the
 28 claims.” *Embrex, Inc. v. Serv. Eng’g Corp.*, 216 F.3d 1343, 1347 (Fed. Cir. 2000) (internal

1 quotation and citation omitted). Claim construction involves considering “the claims themselves,
 2 the remainder of the specification, the prosecution history, and extrinsic evidence concerning
 3 relevant scientific principles, the meaning of technical terms, and the state of the art.” *Phillips v.*
 4 *AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005).

5 The court in *Phillips* emphasized the need to “avoid importing limitations from the
 6 specification into the claims.” *Id.* at 1423. It is a “bedrock principle” of patent law that “the
 7 claims of a patent define the invention to which the patentee is entitled the right to exclude.” *Id.* at
 8 1312. Claims “must be read in view of the specification, of which they are a part.” *Id.* at 1315. In
 9 fact, the Federal Circuit reiterated that the specification “is always highly relevant to the claim
 10 construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a
 11 disputed term.” *Id.* “Ultimately, the interpretation to be given a term can only be determined and
 12 confirmed with a full understanding of what the inventors actually invented and intended to
 13 envelop with the claim. The construction that stays true to the claim language and most naturally
 14 aligns with the patent’s description of the invention will be, in the end, the correct construction.”
 15 *Id.* at 1316. This led the Federal Circuit to conclude that “it is therefore entirely appropriate for a
 16 court, when conducting claim construction, to rely heavily on the written description for guidance
 17 as to the meaning of claims.” *Id.* at 1317. Claim construction also requires consideration of the
 18 prosecution history, which informs “the meaning of claim language by demonstrating how the
 19 inventor understood the invention and whether the inventor limited the invention in the course of
 20 prosecution, making the claim narrower than it would otherwise be.” *Id.*

21 Extrinsic evidence “can help educate the court regarding the field of the invention and can
 22 help the court determine what a person of ordinary skill in the art would understand claim terms to
 23 mean,” but it “is unlikely to result in a reliable interpretation of patent claim scope unless
 24 considered in the context of the intrinsic evidence.” *Id.* at 1319. Such extrinsic evidence may take
 25 the form of expert testimony, dictionaries, technical treatises, and articles. *Vitronics Corp. v.*
 26 *Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996). Courts may not, however, rely on
 27 extrinsic evidence to contradict or vary the meaning of claims provided by the intrinsic evidence.
 28 *Phillips*, 415 F.3d at 1318. “[A] court should discount any expert testimony that is clearly at odds

1 with the claim construction mandated by” the intrinsic evidence. *Id.* at 1318 (citations omitted).
 2 Indeed, an expert’s testimony “may only be relied upon if the patent documents, taken as a whole,
 3 are insufficient to enable the court to construe disputed claim terms. Such instances will rarely, if
 4 ever, occur.” *Vitronics*, 90 F.3d at 1585.

5 **II. TERMS OF THE ‘165 PATENT**

6

7 **A. The “Direct Order Module,” “Purchase Order Module,” and “Electronic
 Requisition Form”**

8 There are two overarching issues to keep in mind when construing the terms “direct order
 9 module,” “purchase order module,” and “electronic requisition form.”

10 The first issue focuses on drawing a clear line between a “direct order module” and a
 11 “purchase order module” to help the jury distinguish one from the other and remain true to Ariba’s
 12 claim amendment that garnered allowance of the patent. Coupa proposes constructions to
 13 establish this distinction: a purchase order module transmits a requisition to an ERP system where
 14 purchase orders are generated for each supplier; a direct order module skips the process of
 15 generating a purchase order and instead transmits the requisition form directly to one or more
 16 suppliers, bypassing the ERP system altogether.

17 The second issue is related to the first, but with the focus shifted the output of the ordering
 18 modules, and not the modules themselves. Claims 35 and 41 recite “transmitting the electronic
 19 *requisition form* directly to at least one supplier,” i.e., the step performed by the direct order
 20 module. Coupa proposes a construction for “electronic requisition form” that helps the jury
 21 understand the distinction between a requisition form and a purchase order. Ariba, on the other
 22 hand, proposes a construction that blurs this distinction and treats a requisition form and a
 23 purchase order as one-and-the-same. This directly contravenes the intrinsic evidence.

24
 25
 26
 27
 28

1 **1. “direct order module” (All Claims)**

Ariba’s Proposed Construction	Coupa’s Proposed Construction ⁴
Software for generating an order against a direct order agreement.	An ordering module that acts on <ins>transmits</ins> a fully approved requisition and transmits the requisition directly to a supplier <ins>based on a direct order agreement</ins> , without storing the requisition in an ERP system or generating a purchase order.

6 The ’165 patent explains and defines a “direct order module.” “The direct order module is
 7 an ordering module that supports communication of orders directly between the buyer and
 8 supplier, without storing the requisition in an ERP system.” [20:64-67.] The direct order module
 9 is used when there is a direct order agreement in place with a supplier (21:4-14), and therefore will
 10 “[t]ransmit[] the requisition directly to the supplier via fax or e-mail” (21:15-16). Claim 35 recites
 11 similar language: “transmitting the electronic requisition form directly to at least one of the
 12 plurality of suppliers based on a direct order agreement between a company employing the user
 13 and the at least one supplier.” [Claim 35 (emphasis added); *see also* Claim 41 (reciting a similar
 14 limitation).] Finally, it is an “ordering module” (19:35-36), which “is the piece of the system that
 15 takes a fully approved requisition and submits it for fulfillment” (19:26-27). Because Coupa’s
 16 proposed construction is aligned with the claim language and tracks the patentee’s definition for a
 17 direct order module, it is the appropriate construction to adopt.

18 Ariba’s construction ignores the definition and description set forth in the patent. It would
 19 also incorrectly allow a single ordering module to satisfy both the “direct order module” and
 20 “purchase order module” limitations, even though it is undisputed that the claimed system cannot
 21 use both the direct order module and the purchase order module for a single order. [Declaration of
 22 Dr. Shamos (“Shamos Decl.”), at ¶ 27 (“a DO module and a PO module are mutually exclusive of
 23 one another”).]⁵ For example, Ariba contends that a “direct order module” is “software for
 24 generating an order against a direct order agreement,” and also contends that a purchase order
 25 module is “software for generating a purchase order.” Under Ariba’s constructions, a single

26
 27 ⁴ Coupa has revised some of its proposed construction to narrow the disputed issues.
 28 ⁵ Underlined language indicates additions, and strikethroughs indicate deletions.

Dr. Shamos’ Declaration was attached to Ariba’s Opening Brief as Dkt. No. 44-4.

1 software module that generates a purchase order would qualify as a purchase order module if
 2 made against a direct order agreement, and would also qualify as a direct order module. In fact,
 3 Ariba's contention is that a "purchase order" and a "direct order" are identical, except for
 4 "whether the order is backed by a direct order agreement." [Ariba's Br. at 24:17-18.] This
 5 contravenes the express language of the claims (i.e., "deciding between" the modules), the
 6 disclosures in the patent (describing two distinct modules), the prosecution history (requiring
 7 separate modules) and Ariba's expert's understanding of the claims (the purchase order module
 8 and direct order module are mutually exclusive (Shamos Decl. at ¶ 27)), and is therefore wrong.

9 In addition, Ariba's construction—"software for [doing X]"—runs afoul of 35 U.S.C. §
 10 112(f) by creating a purely functional definition with no structural boundaries in an attempt to
 11 cover *any* software that performs the stated function. *ePlus, Inc. v. Lawson Software, Inc.*, 700
 12 F.3d 509, 519 (Fed. Cir. 2012) (invalidating system claims where there was "nothing in the
 13 specification to help cabin the scope of the functional language in the means for processing
 14 element: The patentee has in effect claimed everything that generates purchase orders under the
 15 sun."); *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-41 (Fed. Cir. 2008) ("Simply
 16 reciting 'software' without providing some detail about the means to accomplish the function is
 17 not enough."); *see also infra* (discussing the legal standard for claims subject to § 112(f));
 18 Lemley, Mark A., Software Patents and the Return of Functional Claiming (July 25, 2012),
 19 Stanford Public Law Working Paper No. 2117302, at 3 ("It is broad functional claiming of
 20 software inventions that is arguably responsible for most of the well-recognized problems with
 21 software patents."), 5 (proposing "in Part IV . . . that the problem could be solved by applying the
 22 rules of means-plus-function claims to software")⁶. It should therefore be rejected for at least this
 23 additional reason.

24 In sum, the proper construction of a "direct order module" must distinguish between that
 25 module and a "purchase order module." Thus, Coupa's proposed construction should be adopted.
 26
 27

28⁶ This publication is attached to the Duarte Decl. as Ex. 3.

2. "purchase order module" (All Claims)

Ariba's Proposed Construction	Coupa's Proposed Construction ⁷
Software for generating a purchase order.	An ordering module that acts on transmits a fully approved requisition and transmits the requisition to an ERP <u>system adapter</u> , rather than to a supplier , for generating a purchase order

The ’165 patent explains and defines a “purchase order module.” “The purchase order module is an ordering module whose case results in a purchase requisition in the ERP system.” [21:26-27.] Thus, unlike the direct order module, the purchase order module does not transmit the requisition to a supplier, but rather to an ERP adapter. The ERP adapter, in turn, “pushes fully-approved requisitions into the ERP, where they are converted into Purchase Orders on the ERP system.” [23:52-57.] In other words, the purchase order module is not what actually generates purchase orders—that is done by an ERP system after it receives fully-approved requisitions from the purchase order module. Coupa’s construction is consistent with this disclosure, while Ariba’s construction is not.

Ariba argues, without explanation, that Coupa’s proposed construction excludes a stand-alone embodiment. [Ariba’s Br. at 21:9-11; 22:11-21.] First, there is no legal requirement that claims cover every embodiment in the specification. *TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1373 (Fed. Cir. 2008) (“Our precedent is replete with examples of subject matter that is included in the specification, but is not claimed.” (citations omitted)); *Intamin Ltd. v. Magnetar Tech., Corp.*, 483 F.3d 1328, 1337 (Fed. Cir. 2007) (“a claim need not cover all embodiments”). Second, Ariba’s argument lacks a factual basis. The patent’s description of a stand-alone embodiment is a cursory reference at the end of the patent, separate and apart from the patent’s description of the purchase order module. [26:30-42; Cf. 21:25-35.] Thus, the stand-alone embodiment does not use the purchase order module at all. To the contrary, it includes “features of the system that are available only to provide basic functionality when the system is stand-alone: when there is no ERP adapter present,” such as the “ability to print out purchase

1 orders and transmit them to the supplier". [26:30-35 (emphasis added).] This is insufficient to
 2 rebut the patent's explicit definition stating that the "purchase order module is an ordering module
 3 whose case results in a purchase requisition in the ERP system" (21:26-27) and strongly suggests
 4 that the purchase order module does ***not*** contain the ability to generate purchase orders.

5 Ariba's proposed construction covers any software "for generating a purchase order,"
 6 regardless of how the software does it, and even if the software does not itself generate the
 7 purchase order. This is incorrect for the reasons discussed above with respect to functional
 8 claiming in the "direct order module." *See also infra* (discussing the legal standard for means-
 9 plus-function claims).

10 In addition, Ariba's proposed construction expands the scope of the claims to cover
 11 functionality provided in the '165 patent by the ERP system, i.e., that software in an ERP system
 12 can qualify as a purchase order module. [Shamos Decl. at ¶ 23(b) ("when a PO module is selected
 13 that can refer to the generation of a purchase order through an ERP system or outside an ERP
 14 system").] This is wrong because the patent consistently and repeatedly described the purported
 15 invention (i.e., "the system") as integrating with a pre-existing ERP system, not that parts of that
 16 ERP system are included within the purported invention. [*See* 5:1-2 (receipts are "stored in the
 17 system and not integrated with the ERP"); 6:31-49 ("Adapters . . . are software modules that link
 18 the system to the rest of the enterprise. . . . Significant adapters are adapters 804 to the ERP
 19 system in the company."); *see also* 23:45-24:52 (describing "the system" pulling data from an
 20 ERP system); claims 18, 20 (including "adaptor means" that interface with an ERP system).] The
 21 patent expressly defined the purchase order module as transmitting a requisition to an ERP
 22 adapter, not as the software within the ERP system that generates purchase orders. Thus, Ariba's
 23 construction should be rejected, and Coupa's proposed construction should be adopted.

24

25

26

27

28

⁷ To streamline matters for the Court and reduce the number of disputed issues, Coupa has revised its construction as indicated.

1 **3. “electronic requisition form” (claims 35, 41)**

Ariba’s Proposed Construction	Coupa’s Proposed Construction ⁸
An electronic form for requesting goods or services.	A structured document with predefined areas for entering or changing information, wherein the document both An <u>electronic form that</u> constitutes a request for approval to purchase <u>goods or services</u> items from one or more suppliers , and lacks a purchase order number and terms and conditions of an offer.

7 The parties dispute whether a requisition form can also be a purchase order. Ariba seeks to
 8 expand the scope of a “requisition form” so that it covers a purchase order. It does so despite clear
 9 recognition in the ’165 patent that a requisition and purchase order are two different things. It
 10 does so in an attempt to ensnare Coupa’s product, which never transmits requisitions to suppliers
 11 but instead transmits only purchase orders. [See, e.g., Ex. 4 (Ariba’s Infringement Claim Chart) at
 12 57, 68 (alleging that “Coupa e-Procurement Software transmits the requisition to the supplier for
 13 fulfillment *as a purchase order*” (emphasis added)); see also Dkt. No. 12 (Coupa’s Answer) at ¶
 14 64 (explaining that Coupa’s solution “processes requisition forms and uses them to create one or
 15 more purchase orders, but it is always the purchase orders and not the requisition form that are
 16 electronically transmitted to suppliers.”).] Coupa proposes a construction that correctly
 17 distinguishes between a requisition form and a purchase order.

18 According to claim 35, the requisition form is generated based on a user’s responses to a
 19 number of questions. This lines up with the specification’s disclosure of a “requisition record.”
 20 [See, e.g., 8:9-55 (summarizing the fields of a requisition record); 9:35-65 (summarizing the fields
 21 of a line item in a requisition record).] Next, the claim recites deciding between what ordering
 22 module to use, and then “transmitting the electronic requisition form directly to at least one of the
 23 plurality of suppliers based on a direct order agreement.” The reference to the direct order
 24 agreement and “direct” transmission corresponds to the direct order module for reasons explained
 25 in the previous sections. A requisition can include multiple line items from multiple suppliers, and
 26 the claim specifies that the requisition form—in the singular—is transmitted to “at least one

27 8 To streamline matters for the Court and reduce the number of disputed issues, Coupa has
 28 revised its construction to focus on the meaning of a requisition, and not a “form”.

1 supplier.” In other words, the requisition can be transmitted to multiple suppliers, something that
 2 cannot be done with a purchase order. In contrast, when a purchase order is used, its purchase
 3 order number is associated with a line item in a requisition, not the entire requisition. [23:55-57
 4 (“store PO numbers as extrinsic data fields associated with each line item”).]

5 Ariba argues that the specification “repeatedly uses the term ‘requisition’ interchangeably
 6 with ‘order.’” [Ariba’s Br. at 25:1-2 (citing only 7 lines from the patent).] Nothing could be
 7 further from the truth. The specification consistently uses the terms “requisition” and “order” to
 8 refer to different things. For example, “requisition” refers to a user’s initial request for approval to
 9 purchase items (e.g., 7:18-20, 7:36-40, 3:21-23), but when it comes to placing a purchase order,
 10 the specification distinguishes between the two (21:25-34 (“agent typically autocreates a purchase
 11 order from the requisition”), 23:53-57 (“fully-approved requisitions . . . are converted into
 12 Purchase Orders on the ERP system,”) and purchase order numbers are “associated with each line
 13 item [of the requisition”)). The only time that the patent discloses transmitting a requisition to a
 14 supplier is in the context of a “direct order,” not a “purchase order.” The patent explains that a
 15 direct order module “[t]ransmits the requisition directly to the supplier,” and that “[a]ll requisitions
 16 transmitted to the supplier are recorded in the audit trail database.” [21:15-18.] The claims
 17 similarly recite “transmitting the electronic requisition form directly to at least one supplier,” as
 18 opposed to transmitting a purchase order. [Claims 35, 41.] Thus, an appropriate construction in
 19 this context is one that clarifies that an “electronic requisition form” lacks the purchase order
 20 number⁹ and terms and conditions of an offer, since a requisition form is not a purchase order.

21 “The surrounding claim language provides an important consideration for construing a
 22 particular term within a claim.” *Black & Decker, Inc. v. Robert Bosch Tool Corp.*, 260 Fed. Appx.
 23 284, 287 (Fed. Cir. 2008) (citing *Phillips*, 415 F.3d at 1314). Here, claim 35 recites both
 24 “electronic requisition form” and “purchase order,” raising a presumption that those terms have

25
 26 ⁹ Ariba does not contest that a requisition lacks a purchase order number. [See generally,
 27 Ariba’s Br. at 24-25.] That is likely because Tables 1 and 2 of the patent disclose the fields of
 28 a requisition and its line items, and none of those fields include a purchase order number.
 [8:8-50; 9:35-66.] Indeed, Table 1 shows that a requisition has its own unique ID (8:16-8),
 while other parts of the patent disclose each purchase order having a purchase order number
 that is associated with a line item of a requisition (23:55-57).

1 different meanings. *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349
 2 (Fed. Cir. 2012) (“when different words are used in separate claims, they are presumed to have
 3 different meanings” (citation omitted)).

4 Finally, Ariba’s proposed construction is too generic and strips the term of its essential
 5 meaning, because it does not specify that a requisition form is a request *for approval* to purchase
 6 items. The ’165 patent describes a requisition in the context of an automated approval process.
 7 [E.g., 10:23-26 (“the system will perform the following checks before actually submitting the
 8 requisition for approval”); *see generally* 7:18-10:55; Fig. 3.] Table 1 of the patent summarizes the
 9 fields of a requisition, and includes an “Approved Date” field specifying the “[d]ate and time on
 10 which the requisition was fully approved.” [8:9-50 (intrinsic field 8); *see also* 7:8 (“An intrinsic
 11 field is a field that the system expects to find.”).] Without the words “for approval,” Ariba’s
 12 construction would cover purchase orders, which as explained above, is incorrect.

13 **B. The Means-Plus-Function Limitations (35 U.S.C. § 112(f))**

14 The parties agree that several of the claim terms at issue are drafted in “means-plus-
 15 function” form. 35 U.S.C. § 112(f). When a patentee claims a generic “means” for implementing
 16 a given function, special narrowing rules apply to limit the scope of the claim to cover only those
 17 specific structures disclosed in the patent specification, and their equivalents. *Ergo Licensing,*
 18 *LLC v. CareFusion 303, Inc.*, 673 F.3d 1361, 1363 (Fed. Cir. 2012). Construction of a means-
 19 plus-function claim limitation therefore requires a two-step process: “first identify the function of
 20 the limitation; . . . then look to the specification and identify the corresponding structure for that
 21 function.” *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007).

22 If the patent fails to disclose adequate structure for performing the recited function, it
 23 “amounts to impermissible pure functional claiming,” and the claim including that limitation is
 24 invalid for indefiniteness under 35 U.S.C. § 112(b). *Ergo Licensing*, 673 F.3d at 1363. “To meet
 25 the definiteness requirement, structure disclosed in the specification must be clearly linked to and
 26 capable of performing the function claimed by the means-plus-function limitation.” *Default Proof*
 27 *Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1299 (Fed. Cir. 2005). If a
 28 patent specification simply repeats the function recited in a means-plus-function claim limitation,

1 without also disclosing specific structure for performing the function, the limitation cannot be
 2 construed and is invalid as indefinite. *Biomedino*, 490 F.3d at 952-53.

3 It is legally insufficient that a person of ordinary skill in the art at the time of the alleged
 4 invention knew or could figure out an algorithm to implement the function; under § 112(f), the
 5 “indefiniteness inquiry is concerned with whether the bounds of the invention are sufficiently
 6 demarcated, not with whether one of ordinary skill in the art may find a way to practice the
 7 invention.” *ePlus*, 700 F.3d at 519; *see also Ergo Licensing*, 673 F.3d at 1364 (“Although one of
 8 skill in the art may have been able to find a structure that would work, that does not satisfy §
 9 [112(f)].”); *Blackboard Inc. v. Desire2Learn Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009) (“That
 10 ordinarily skilled artisans could carry out the recited function in a variety of ways is precisely why
 11 claims written in ‘means-plus-function’ form must disclose the particular structure that is used to
 12 perform the recited function.”).

13 A special situation arises when, as in the present case, the corresponding structure for a
 14 means-plus-function limitation includes software running on a general purpose computer. In such
 15 a circumstance, the Federal Circuit has consistently held that the required “structure”
 16 corresponding to the claimed function must also include the specific algorithm by which the
 17 computer performs the claimed function. *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game*
 18 *Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (“The corresponding structure for a § [112(f)] claim
 19 for a computer-implemented function is the algorithm disclosed in the specification.”); *WMS*
 20 *Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1348 (Fed. Cir. 1999); *Ergo Licensing*, 673
 21 F.3d at 1364 (“Requiring disclosure of an algorithm properly defines the scope of the claim and
 22 prevents pure functional claiming.”); *Blackboard*, 574 F.3d at 1385.

23 The Federal Circuit has explained the reason for this additional requirement as follows:
 24 “For a patentee to claim a means for performing a particular function and then to disclose only a
 25 general purpose computer as the structure designed to perform that function amounts to pure
 26 functional claiming. Because general purpose computers can be programmed to perform very
 27 different tasks in very different ways, simply disclosing a computer as the structure designed to
 28 perform a particular function does not limit the scope of the claim to ‘the corresponding structure,

1 material, or acts' that perform the function, as required by [35 U.S.C. § 112(f)]." *Aristocrat*, 521
 2 F.3d at 1333. Therefore, in construing a means-plus-function limitation that is implemented by a
 3 computer, it is necessary for the Court to determine what computer-implemented algorithm is
 4 disclosed in the patent for performing the recited function. *Id.* If no specific algorithm is "clearly
 5 linked" by the patent specification to performing the function recited in a means-plus-function
 6 limitation, the patent fails to disclose the structure necessary for claim construction, and the claim
 7 is indefinite as a matter of law. *See id.*, at 1330-38.

8 **1. "order generating means for deciding between at least one of a purchase**
 9 **card module, a direct order module, and a purchase order module to**
submit the requisition for fulfillment by a supplier" (Claim 1)

Ariba's Proposed Construction	Coupa's Proposed Construction
Function: Deciding between a set of ordering modules, the set including at least one purchase card module, one direct order module, and one purchase order module, where the chosen module or modules is/are used as part of the process to submit an order for one or more line items. Structure: [See Dkt. No. 39-1 (Jt. Claim Construction Chart) at 1-2.]	Function: a computer choosing only one module to submit the requisition for fulfillment by a supplier, wherein the computer chooses from among at least a purchase card module, a direct order module, and a purchase order module Structure: There is insufficient structure under <i>Blackboard</i> , 574 F.3d at 1371 to support the recited function.

17 The parties generally agree that the order generating means involves choosing from among
 18 at least three ordering modules, but dispute whether it may choose more than one of these modules
 19 for a single order. For the reasons explained below, it may only choose one such module.

20 **a. The Function**

21 Because this is a means-plus-function limitation, the first thing to construe is the function.
 22 As always, we first turn to the claim language. *See, e.g., Phillips*, 415 F.3d at 1312 ("we look to
 23 the words of the claims themselves . . . to define the scope of the patented invention" (citation
 24 omitted)). The plain meaning of the phrase "deciding between" multiple choices suggests that
 25 only one choice is selected, not multiple ones. For example, if someone is "deciding between" a
 26 sedan, an SUV, and a mini-van to buy, they will pick only one of them, not two or three of them.

27 The specification discloses that the system chooses only one module for any given order.
 28 In particular, under the section titled "Ordering Modules," the '165 patent discloses that "[w]hen a

1 requisition has been fully approved, the system will . . . [c]heck the requisition to determine which
 2 suppliers are involved, and . . . [c]hoose the preferred ordering module *for each of those suppliers*
 3 and use it to transmit the order.” [19:25-34.] Critically, the specification uses the singular tense to
 4 describe the chosen “preferred ordering module” and then using “*it*” to transmit the order. [See
 5 *also* 4:49-53 (“determine the preferred method of ordering . . . and use **that** method for
 6 transmitting” (emphasis added)).] There is no disclosure in the patent of using multiple ordering
 7 modules to submit a single order for fulfillment from a single supplier. Moreover, during the
 8 prosecution of the patent application, the patentee stressed that the prior art purportedly did not
 9 disclose a “decision making process to choose a preferred ordering method,” again, using the
 10 singular tense. [Ex. 1 at ARICOU000529-530.] Even Ariba’s expert agrees that only one module
 11 can be used for transmitting an order. [Shamos Tr., at 66:3-11 (“the actual transmission is done by
 12 one module”).] Thus, the intrinsic evidence supports Coupa’s construction: “deciding between”
 13 means choosing only one module for a given order.

14 Ariba argues that the “at least one” language in the claim supposedly means that more than
 15 one module may be chosen. [Ariba’s Br. at 2-3.] But the “at least one” phrase merely reflects that
 16 there can be more than one supplier for multiple line items in a requisition from which to “decide
 17 between,” not that more than one module can be chosen for the same order. Ariba then argues that
 18 a requisition can contain multiple line items, and a different module may be chosen for each line
 19 item. [*Id.* at 3-4.] In any event, when the specification refers to choosing a preferred module, it
 20 refers to a choice made “for each” supplier in a requisition. [19:30-34.] Thus, the “deciding
 21 between” limitation refers to a decision made for a supplier, not the compilation of decisions made
 22 for a requisition that involves multiple suppliers.

23 Ariba next argues without support that a purchase card module can be “chosen together
 24 with either a DO module or a PO module.” [Ariba’s Br. at 4:11-12.] But the specification does
 25 not disclose such a combination. In fact, the language Ariba cites to supports the opposite
 26 conclusion because it specifies that when a purchase card cannot be used, the system “chooses a
 27 different ordering module.” [20:5-8 (“Ensure that the supplier accepts p-cards. If not, chooses a
 28 different ordering module.”); 20:9-12 (“If the supplier has a ghosted p-card number” or “the

1 employee has a p-card number: uses it. Otherwise, chooses another ordering module.”); 20:13-5
 2 (“If [the amount of the purchase] exceeds the per-transaction limit on the purchasing card, then
 3 chooses some other ordering module.”).] This language strongly suggests that if a purchase card
 4 is used, then the system will not choose a different ordering module. Otherwise, there is no
 5 support for the claimed function of combining multiple ordering modules, and the “chooses a
 6 different ordering module” language in the specification is superfluous. Moreover, as Ariba’s
 7 expert admits, a purchase card module can itself transfer an order, so it does not actually have to
 8 be combined with another ordering module. [Shamos Tr. at 77:5-6 (“Q. And the p-card module
 9 can be used to transfer an order; correct? A. Yes, you could.”); 94:4-8.]

10 Ariba also proposes construing the phrase “to submit the requisition for fulfillment by a
 11 supplier” to mean “where the chosen module or modules is/are *used as part of the process* to
 12 submit an order for one or more line items,” while Coupa proposes that no construction for that
 13 phrase is necessary. Ariba is silent on this point, and rightfully so. Coupa can only surmise that
 14 Ariba is trying to broaden the claim by referring to modules being “used as part of” some vague
 15 “process.” Given that Ariba offers no support for its proposed phrase, it should be rejected.

16 **b. There is Insufficient Corresponding Structure**

17 After construing the function, the next step is to determine the corresponding structure
 18 disclosed in the patent, if any exists. Here, there is insufficient structure to support either party’s
 19 proposed function, rendering claim 1 invalid pursuant to § 112(f). Ariba only offers structure for
 20 its proposed function, not Coupa’s. Ariba contends that the patent discloses whether or not to use
 21 a purchase card module, and then deciding between a purchase order module and direct order
 22 module. [Ariba’s Br. at 5:16-18; 6:23-7:4.] However, as discussed above, the patent does not
 23 actually disclose combining the purchase card module with either of the two other modules; that
 24 comes only from Ariba’s expert as described below. In fact, such a combination is unnecessary
 25 because the purchase card module can itself transmit an order. [Shamos Tr., at 77:5-6; 94:4-8.]
 26 And therein lies the problem; a person of ordinary skill at the time of the alleged invention, upon
 27 reading the patent, is left to guess how to decide whether a purchase card module should be used
 28 by itself to transmit an order (as Coupa contends), or whether it should be combined with other

1 ordering modules (as Ariba contends). Because the patent does not specify how the claimed
 2 function is performed, i.e., it fails to disclose the specific algorithm for making the decision, it has
 3 failed to disclose sufficient corresponding structure.

4 Tellingly, Ariba only cites its expert—not the patent—when it discusses the possibility of
 5 combining a purchase card module with the other modules. [Ariba’s Br. at 6:23-7:7.] The gist of
 6 the declaration is that a person of ordinary skill in the art could have figured out some way to
 7 implement the patent. This is legally insufficient to satisfy the rigors of means-plus-function
 8 claiming. *Function Media, L.L.C. v. Google, Inc.*, 708 F.3d 1310, 1319 (Fed. Cir. 2013) (“Having
 9 failed to provide any disclosure of the structure for the ‘transmitting’ function, FM cannot rely on
 10 the knowledge of one skilled in the art to fill in the gaps.”). A “patentee cannot avoid providing
 11 specificity as to structure simply because someone of ordinary skill in the art would be able to
 12 devise a means to perform the claimed function.” *Id.* (citing *Blackboard*, 574 F.3d at 1385).

13 Finally, contrary to Ariba’s contention, the language cited in column 20, lines 5-9, cannot
 14 constitute the structure for deciding whether to choose a purchase card module because that
 15 language refers to steps performed by the purchase card module itself—*i.e.*, by the time those
 16 steps are performed, the decision to use a purchase card module has already been made. [20:1-9
 17 (“The purchasing card module: . . . verifies whether a p-card can be used for this purchase.).]

18 **2. “deciding between at least one of a purchase card module, a direct
 19 order module, and a purchase order module to submit the electronic
 requisition form for fulfillment” (Claims 35, 41)**

20 Ariba contends that this limitation in claims 35 and 41 – which substantially lifts the
 21 concededly means-plus-function language of claim 1, and drops the words “means for” – is not
 22 governed by 35 U.S.C. § 112(f). Indeed, there is a rebuttable presumption that § 112(f) is not
 23 invoked when the claim language does not contain the word “means.” *Phillips*, 415 F.3d at 1311.
 24 However, the “lack of such [means] language does not prevent a limitation from being construed
 25 as a means-plus-function limitation.” *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1214
 26 (Fed. Cir. 1998) (emphasis in original) (affirming that “lever moving element” was subject to
 27 section 112(f) because otherwise “a ‘moving element’ could be any device that can cause the lever
 28 to move”). The *Mas-Hamilton* court declined to construe a “lever moving element” . . . so

broadly to cover every conceivable way or means to perform the function of moving a lever.” *Id.* Here, too, “deciding between” should not be construed so broadly to cover any conceivable way of making a decision. Ariba has already conceded, without argument, that the virtually identical language in claim 1 is subject to § 112(f), and thus that its requisite structure comes from the patent’s specification – not from the claim language. It is illogical and inconsistent to argue, as Ariba does, that claims 35 and 41 recite sufficient structure, while the identical language of claim 1, merely preceded by the words “means for,” does not. The claim language should be subject to § 112(f) to conform to Federal Circuit law and to preserve internal consistency.

9 To the extent this term is subject to § 112(f), the claims are invalid for lack of sufficient
10 corresponding structure for at least the reasons set forth with respect to the “order generating
11 means” limitation. Alternatively, Coupa’s proposed function, which mirrors the function set forth
12 for the “order generating means” limitation, should be adopted as the proper construction.

3. “approval path handling means for guiding the requisition record along the determined approval path, wherein the approval path handling means generates a global approval indication based on the commentary entry and in response to the requisition record successfully traversing the approval path” (Claim 1)

Ariba's Proposed Construction	Coupa's Proposed Construction
<p>Function: Guiding the requisition record along the determined approval path.</p> <p>Structure: [See Dkt. No. 39-1 (Jt. Claim Construction Chart) at 1-2.]</p>	<p>Function: guiding the requisition record along the determined approval path, and generating a global approval indication based on the commentary entry and in response to the requisition record successfully traversing the approval path.</p> <p>Structure: There is insufficient structure to support the recited function.</p>

The parties dispute whether the limitation “wherein the approval path handling means generates a global approval indication based on the commentary entry” should be read out of the claim (as Ariba contends), and whether the patent discloses sufficient corresponding structure.

When a patent claim includes a “wherein” clause, it limits the scope of the claim if it “expresses the inventive discovery” rather than “merely stat[ing] the inherent result” of performing the claimed functionality. *Intergraph Hardware Techs. Co. v. Toshiba Corp.*, 508 F. Supp. 2d 752, 768-69 (N.D. Cal. 2007) (citing *Griffin v. Bertina*, 285 F.3d 1029, 1034 (Fed. Cir.

1 2002)) (construing “wherein” clause as part of the function). Here, the function of “generating a
 2 global approval indication based on the commentary entry” is not the inherent result of “guiding
 3 the requisition record along the determined approval path.” For example, simply guiding a
 4 requisition record does not mean that the requisition record will receive global approval (let alone
 5 based on the commentary entry). Moreover, the claim does not recite “obtaining” or “receiving”
 6 global approval—it recites “generating” an indication of such global approval (based on the
 7 commentary entry, no less), a function that can be performed independently of guiding the
 8 requisition record. Thus, the “wherein” clause is limiting, and the “approval path handling means”
 9 must be construed to perform both recited functions.

10 Ariba’s expert contends that there is no disclosure of a system that generates a global
 11 approval indication “based on the commentary entry.” [See Shamos Tr. at 131:4-7.] Coupa
 12 agrees; there is no structure to support Coupa’s proposed function, rendering the claim invalid. As
 13 for the structure Ariba proposes, it does not save the claim because it is itself functional, i.e., Ariba
 14 proposes “software that [performs functions].” *Finisar*, 523 F.3d at 1340-41 (“Simply reciting
 15 ‘software’ without providing some detail about the means to accomplish the function is not
 16 enough.”). For example, the phrase “pass[ing] the requisition record to the next required
 17 approver” in Ariba’s proposed structure restates the function of “guiding” with the term “passing”;
 18 it does not state how the requisition is guided along a path. As another example, Ariba’s excerpt
 19 from Figure 3c simply shows that multiple approvals are involved, but again fails to show how the
 20 requisition is actually guided from one approver to the next. Citations to black-box functions in
 21 the specification provide insufficient support for a means-plus-function limitation. *See, e.g.,*
 22 *Blackboard*, 574 F.3d at 1382; *ePlus*, 700 F.3d at 518 (finding “step 114 in Figure 3” to be “just a
 23 black box that represents the purchase-order-generation *function* without any mention of a
 24 corresponding structure” (emphasis in original)).

25 Interestingly, Ariba’s expert apparently contends that when the claim refers to
 26 “generat[ing] a global approval indication based on the commentary entry,” it means that a
 27 “[human] approver needs to look at the commentary entry in order to decide whether to approve or
 28 not approve the requisition.” [Shamos Tr., at 127:5-128:13 (emphasis added).] This mixes an

1 apparatus claim with a method claim—i.e., it requires a human user to approve a requisition based
 2 on his review of a commentary entry, a step that can only be satisfied if he actually reviews the
 3 commentary entry. Such mixed apparatus-method claims are invalid as a matter of law. *See, e.g.*,
 4 *IPXL Holdings, LLC v. Amazon.com*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (“reciting both an
 5 apparatus and a method of using that apparatus renders a claim indefinite”).

- 6 **4. “approval path determining means, responsive to the requisition record
 7 to approval rules in an approval rules database, for determining an
 8 approval path for the requisition record, among various ones of a
 plurality of possible approvers, required to approve the requisition
 record based on the commentary entry” (Claim 1)**

Ariba's Proposed Construction	Coupa's Proposed Construction
Function: Determining an approval path for the requisition record	Function: in response to the requisition record to approval rules in an approval rules database, determining which approvers need to approve the requisition record, and in what order, wherein the approvers and order is determined based on the commentary entry
Structure: [See Dkt. No. 39-1 (Jt. Claim Construction Chart) at 1-2.]	Structure: There is insufficient structure to support the recited function.

15 The parties dispute four main issues concerning this means-plus-function limitation.

16 The first issue concerns the recited phrase “based on the commentary entry.” Similar to
 17 “approval path handling” means limitation, either the system determines the approval path based
 18 on the commentary entry (as Coupa proposes), or a human approver must be required to approve a
 19 requisition based on the commentary entry (as Ariba apparently proposes). In either case, the
 20 claim is invalid as indefinite, either for lack of corresponding structure, or for mixing a system
 21 claim with a method claim.

22 The second issue concerns construing the phrase “determining an approval path.” The
 23 patent provides scant guidance, but it does mention that “the system checks the approval rules of
 24 the company, decides which users need to approve the request, and in what order.” [10:61-64.]
 25 According to this disclosure, “determining an approval path” refers to “determining which
 26 approvers need to approve the requisition record, and in what order.”

27 The third issue concerns the unintelligible phrase “responsive to the requisition record to
 28 approval rules in an approval rules database.” Ariba contends that it made a scrivener’s error

1 when it prosecuted the patent, and relies on one line in the patent and the seven years of
 2 prosecution history to support its argument. Now, over sixteen months after Ariba filed suit,
 3 Ariba urges this Court to fix the claim by inserting “and” into the claim. If Ariba believed this to
 4 be a scrivener’s error, it should have sought a certificate of correction from the Patent Office to
 5 provide the public with notice of the actual scope of claim 1.

6 The fourth issue concerns whether the specification discloses sufficient structure to support
 7 the recited function. There is no dispute that under Coupa’s proposed function, there is
 8 insufficient corresponding structure, and thus the claim is invalid. [Shamos Tr. at 131:4-7.] But
 9 even if Ariba’s proposed function is adopted, the patent fails to disclose sufficient corresponding
 10 structure to support it. In particular, Ariba contends that “approval software” constitutes sufficient
 11 structure because it “inspects the approval rules of the company, [and] decides who needs to
 12 approve the request . . .” [Ariba’s Br. at 11:11-23 (quoting the ’165 patent at 4:18-22).]
 13 However, the patent does not disclose how such “approval software” works, does not disclose the
 14 software’s specific algorithms as required by law, nor does it disclose any set of approval rules or
 15 even how the approval rules are inspected by the “approval software.” [Shamos Tr., at 134:21-
 16 135:2 (agreeing the patent “doesn’t disclose the rules themselves”).] It simply “describes an
 17 outcome, not a means for achieving that outcome.” *Blackboard*, 574 F.3d at 1384 (finding
 18 description of an “Education support system” insufficient because the language “simply
 19 describe[d] the function to be performed” and said “nothing about how the access control manager
 20 ensures that those functions are performed” (citing *Aristocrat*, 521 F.3d at 1334)); *see also Net*
 21 *MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1365-67 (Fed. Cir. 2008) (rejecting argument that
 22 disclosure of a “bank computer” provided sufficient structure under § 112(f)). Similarly, the box
 23 from Figure 3 that Ariba cites to fails to disclose an algorithm because it is only a recitation of an
 24 intended result, not a description of how to achieve it. *ePlus*, 700 F.3d at 518 (finding “step 114 in
 25 Figure 3” to be “just a black box that represents the purchase-order-generation *function* without
 26 any mention of a corresponding structure” (emphasis in original)).

27 Ariba contends that “one skilled in the art would recognize how . . . the system determines
 28 an approval path.” [Ariba’s Br. at 12:6-8 (citing thirteen paragraphs from Dr. Shamos’ declaration

1 without explanation).] Dr. Shamos states that “the full set of approval rules comprise an algorithm
 2 which maps any requisition to a valid approval path.” [Shamos Decl. at ¶ 63.] However, in
 3 deposition, he admitted that the patent “doesn’t disclose the rules themselves.” [Shamos Tr. at
 4 134:21-2.] Without the rules, there is no algorithm. It is irrelevant whether a person of ordinary
 5 skill may know algorithms to use to perform the recited function, since Ariba may not claim every
 6 possible set of approval rules. *Blackboard*, 574 F.3d at 1385 (“The correct inquiry is to look at the
 7 disclosure of the patent . . . not simply whether one of skill in the art would have been able to
 8 write such a software program.” (emphasis in original)); *ePlus, Inc.*, 700 F.3d at 519 (invalidating
 9 system claims where there was “nothing in the specification to help cabin the scope of the
 10 functional language in the means for processing element: The patentee has in effect claimed
 11 everything that generates purchase orders under the sun.”). Because the patent does not disclose
 12 any one algorithm for determining an approval path, claim 1 is invalid.

13 **5. “requisition record generating means . . .” (Claim 1)**

14 Ariba proposed this term for construction, despite neither party believing it would be case
 15 or claim dispositive. [Dkt. No. 39 (Jt Claim Construction Stmt) at 4:20-23.] The parties only
 16 dispute the structure. Coupa proposes a structure consisting of the steps disclosed within Box 302
 17 of Figures 3a and 3c, and their description in the prose of the specification, wherein the requisition
 18 record contains the fields disclosed in Tables 1 and 2. [See Figs. 3a, 3c, 7:35-10:54.]

19 Ariba contends that the requisition is “generated” as soon as a blank requisition record is
 20 created, and that the steps for filling out a requisition should be excluded. [Ariba’s Br. at 19:15-
 21 20.] This ignores that claim 1 requires that a requisition be generated in response to “input by a
 22 requester including a commentary entry;” simply generating a blank requisition record is
 23 insufficient. Ariba then argues that the steps in Box 302 are not steps for generating a requisition.
 24 [Ariba’s Br. at 20:13-22.] But the specification says otherwise: “In FIG. 3, the reference numeral
 25 302 designates process steps associated with creating a requisition.” [3:21-23.]

26 Ariba also tries to exclude Tables 1 and 2 from the corresponding structure, arguing that
 27 other embodiments are possible. [Ariba’s Br. at 20:23-28 (citing the ’165 Patent at 7:2-5).]
 28 However, when a patentee chooses to draft a claim in a means-plus-function format, he is limited

1 to the embodiments actually disclosed, not any possible embodiment. *Ergo Licensing*, 673 F.3d at
 2 1363. Moreover, Ariba omits the portion of the specification explaining that with respect to
 3 Tables 1 and 2, “[a]n extrinsic field is an additional custom field” (7:9-16), while “[a]n intrinsic
 4 field is a field that the system expects to find” (7:8). Thus, a requisition record must contain the
 5 intrinsic fields shown on Tables 1 and 2.

6 **6. “electronic receipt generating means . . .” (Claim 1)**

7 Ariba also proposed this term for construction, despite neither party believing it would be
 8 case or claim dispositive. [Dkt. No. 39 at 4:16-19.] There are two disputes.

9 First, the “wherein” clause should not be excluded from the function because it “expresses
 10 the inventive discovery” rather than “merely stat[ing] the inherent result” of performing the
 11 claimed functionality. *Intergraph Hardware*, 508 F. Supp. 2d at 768-69; *Griffin*, 285 F.3d at
 12 1034. Receipts do not inherently “indicate[] one of an acceptance or rejection of a received
 13 operating resource,” i.e., a receipt does not typically indicate that you rejected something. Nor do
 14 receipts inherently “facilitate[] payment;” indeed, were it otherwise, claim 35 would not recite
 15 “generating an electronic receipt” and “facilitating payment” as two separate claim limitations.

16 Second, the structure for performing the claimed function should be construed as
 17 “providing an employee with a form having the fields shown in Table 15, where the form allows
 18 an employee to take the steps 1(a)-(b) disclosed on col. 21, lines 56-67.” [Dkt. No. 39-1 (Jt Claim
 19 Construction Chart) at 7-8.] The specification discloses that “[t]he system provides a simple form
 20 (the fields of which are shown below in Table 15) for the employee to indicate that he or she has
 21 physically received an item” (21:52-54), and then describes the steps an employee can take to
 22 acknowledge receipt of an ordered item (21:56-67). The fields in Table 15 are not described as
 23 optional, and consist of the only embodiment disclosed for generating a receipt.

24 Ariba contends there is another embodiment for generating a receipt, but what Ariba
 25 cites—“user interface for acknowledging receipt, which allows employees to acknowledge that
 26 various items have been received”—hardly constitutes an algorithm because it would cover any
 27 user interface without regard to how it actually operates.

28

1 Dated: July 26, 2013

FISH & RICHARDSON P.C.

2 By: /s/ Enrique D. Duarte
3 Enrique D. Duarte

4 Attorney for Defendant
5 COUPA SOFTWARE INC.

6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28